

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GRANT HEPBURN

Appeal No. 2004-1701
Application No. 09/697,647

ON BRIEF

Before PAK, WALTZ and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 19-22, 24 and 25, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a fuel tank protector for a motorcycle. An understanding of the invention can be derived from a reading of exemplary claim 19, which is reproduced below.

19. A motorcycle fuel tank protector comprising a pair of resilient cover members each of which is shaped to substantially conform to and bound a respective side frontal portion of the fuel tank that is prone to stone chip damage,

each cover member being removably attached to and spaced from said corresponding side frontal portion in

use solely by a plurality of resilient suction connectors distributed over the inner surface of said cover member,

each said suction connector including a suction cup portion releasably engagable with side frontal portion.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wagner	4,969,674	Nov.13, 1990
Thurm	5,884,380	Mar. 23, 1999

Claims 19-22, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thurm in view of Wagner.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Upon consideration of the respective positions advanced by appellant and the examiner with respect to the rejection that is before us for review, we find ourselves in agreement with appellant's position in that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. Accordingly, we will not sustain the examiner's § 103(a) rejection.

While Thurm discloses a motorcycle gas tank cover, the examiner basically acknowledges that Thurm does not disclose that the tank protective cover includes a plurality of resilient suction connectors distributed over the inner surface of each cover member and that each such connector has a suction cup portion releasably engageable with a side frontal portion of the motorcycle fuel tank. Rather, Thurm teaches that the cover members are secured to the motorcycle with nuts and bolts passing through flanges connected to the tank cover members. See, e.g., column 2, lines 60-67 and drawing figures 5a and 5b of Thurm. While Wagner does disclose securing a side bumper to a passenger vehicle side door with a plurality of suction cups (30, figures 2 and 5) in combination with a locking device (32, figures 2 and 6), the examiner has not reasonably explained how the teachings of using suction cups and a locking device for a side bumper as taught in Wagner would have led one of ordinary skill in the art to replace the nut and bolt assembly of Thurm with suction cups only sold for securing a motorcycle gas tank cover.

In this regard, the examiner has not provided adequate evidence that suction cup connectors by themselves are interchangeable with nuts and bolts for securing, solely in use, covers of the type taught by Thurm to the external surface of a

motorcycle gas tank. While suction cups may be well known for use in attachment of other items to other portions of a different type of vehicle, such as an automobile as acknowledged by appellant (4th page of the brief), the examiner has not fairly explained how those other uses of suction cups would have reasonably led one of ordinary skill in the art to employ a plurality of suction cup connectors arranged as here claimed as a substitute for a nuts and bolt arrangement for holding Thurm's motorcycle gas tank covers in place. Moreover, the examiner has not explained why Wagner, even if considered combinable with Thurm, would have suggested the here claimed covers, "each of which is shaped to substantially conform to and bound a respective side frontal portion of the fuel tank..." and that are constructed as being solely attachable by a plurality of suction cup connectors in use. In this regard, Wagner teaches using a locking device in addition to suction cups for a side door bumper as noted by appellant and Thurm discloses a motorcycle gas tank cover that generally conforms to the shape of a gas tank, not shaped to conform to and form a boundary of "a side frontal portion of the fuel tank" (emphasis added).

The examiner must provide specific reasons or suggestions for combining the particular teachings and disclosures of the

applied references so as to arrive at the claimed subject matter with a reasonable expectation of success in so doing. In this context, the examiner's rejection falls short in not identifying a convincing and particularized suggestion, reason or motivation to combine the references or make the proposed modification in a manner so as to arrive at the claimed invention. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

For the foregoing reasons, we determine that the examiner has not established a prima facie case of obviousness in view of the reference evidence.

CONCLUSION

The decision of the examiner to reject claims 19-22, 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Thurm in view of Wagner is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Page 7

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